

## **REMARKS**

### **I. INTRODUCTION**

Claim 1 has been amended. Thus, claims 1-9 and 11 remain pending in the present application. No new matter has been added. In light of the above amendments and the following remarks, Applicants respectfully submit that all presently pending claims are in condition for allowance.

### **II. THE 35 U.S.C. § 103(a) REJECTION SHOULD BE WITHDRAWN**

Claims 1-9 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Melkent et al. (U.S. Patent No. 6,725,080) in view of Gordon (U.S. Patent No. 5,938,645).

Claim 1 recites, “[a] catheter system, comprising: a first catheter element with at least a *first active localizer corresponding to a portion of the first catheter element*, the first active localizer indicating a spatial position of the portion of the first catheter element; and a *second catheter element with at least a second active localizer corresponding to a portion of the second catheter element*, the second active localizer indicating a spatial position of the portion of the second catheter element, *wherein the first and the second catheter element are slidably coupled*, and *wherein the first and the second active localizers simultaneously indicate the spatial positions of the portions of the first and second catheter elements*.”

Melkent discloses an image-guided surgical navigation system (200) which tracks the position of a tool guide (125) and an anatomical reference frame (260) attached to a patient (202). (*See Melkent*, Abstract, Fig. 2). The tool guide comprises multiple cannulas (127) which a surgeon can use to pass a surgical implement (i.e. tool) through to aid in a surgical procedure. (*See Id.*, col. 7, ll. 22-28). The cannulas comprise a trackable marker (121) “to allow the surgeon to properly position and orient the tool guide into the anatomy for implement placement.” (*See Id.*, col. 4, ll. 18-22). However, it is clear from Melkent that the cannulas are in a fixed relationship with one another. (*See e.g., Id.*,

Figs. 3, 4a and 4b). Claim 1 recites, “*the first and the second catheter element are slidably coupled.*” It is not clear which element is considered by the Examiner to be slidably coupled to the cannulas (127) of the tool guide (125). If the Examiner deems such element to be the “surgical implements, such as drills or other tools, and/or devices, such as cannulated screws, nails, etc” (See *Id.*, col. 4, ll. 27-28), those are not implements that have a *second active localizer*, as recited in claim 1. Therefore, it is respectfully submitted that, Melkent fails to disclose or suggest *a second catheter element with at least a second active localizer corresponding to a portion of the second catheter element, the second active localizer indicating a spatial position of the portion of the second catheter element.*”

Applicants understand that the Examiner is relying on Gordon to teach the first and second catheter elements of claim 1. Specifically, Gordon discloses “a catheter having proximal and distal ends, designed to be advanced through a hemostasis valve and guide catheter over a guide wire.” However, Gordon fails to disclose or suggest first and second trackable markers, as recited in claim 1. More importantly, the Examiner fails to articulate exactly what the combination of Melkent and Gordon would disclose. The Applicants respectfully remind the Examiner that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” (See, MPEP 706). If the Applicants understanding of the Examiner’s rejection is incorrect, the Applicants respectfully request that the Examiner issue a new Non-Final action to more clearly articulate any rejection.

Turning back to the rejection, is it the Examiner’s position that one of the cannulas of Melkent can be replaced with the catheter of Gordon? If this is the case, then the combined teaching would merely show a catheter having one trackable marker either on Gordon’s catheter or guide wire. Or is it the position of the Examiner that the trackable marker on the catheter of Gordon that replaced one of the cannulas of Melkent includes a first marker and one of the remaining cannulas includes a second marker? In

this case, the combined teaching would not include a second catheter with a second marker that is slidably coupled to the first catheter.

Therefore, Applicants respectfully submit that Melkent and Gordon, taken alone or in combination, fail to disclose or suggest *“a second catheter element with at least a second active localizer corresponding to a portion of the second catheter element, the second active localizer indicating a spatial position of the portion of the second catheter element, wherein the first and the second catheter element are slidably coupled, and wherein the first and the second active localizers simultaneously indicate the spatial positions of the portions of the first and second catheter elements,”* as recited in claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn. Because claims 2-5 depend on and, therefore, contain all of the limitations of claim 1, it is respectfully submitted that these claims are also allowable.


Claim 7 recites, “a) determining a spatial position of the first active localizer relative to the vascular system; and b) determining a spatial position of the second active localizer relative to the spatial position of the first active localizer, wherein the determining steps are performed substantially simultaneously.” Therefore, it is respectfully submitted that claim 7 is allowable for at least the foregoing reasons presented with regards to claim 1. Because claims 8, 9, and 11 depend on and, therefore, contain all of the limitations of claim 7, it is respectfully submitted that these claims are also allowable.

**CONCLUSION**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: March 23, 2010

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